

### **Remarks/Arguments**

Claims 1-8, and 10-77 are pending in the application. Claims 1, 23, 30, 37, 49, and 61 have been amended. Claim 9 has been canceled without prejudice. Favorable reconsideration of the application, as amended, is respectfully requested.

#### **I. REJECTIONS OF CLAIMS 1-77 UNDER 35 U.S.C. §§ 102 AND 103**

Claims 1-3, 7, 11, 13-15, 30, 31, 35, 37-39, 45-51, 57-63, 67, 71, and 73-77 stand rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,598,027 ("Breen"). Claims 1-3, 6, 8, 11, 13-15, 30, 31, 34, 36-39, 42, 45-47, 49-51, 54, 57-59, 61-63, 66, 68, and 71-74 stand rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent Publication No. US 2001/0042021 A1 ("Matsuo").

Claims 9, 10, 12, 16, 17, 21, 23, 24, 28, 43, 44, 55, 56, 69, 70, and 72 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Breen. Claims 9, 10, 12, 16, 17, 20, 22-24, 27, 29, 43, 44, 55, 56, 69, 70, and 72 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Matsuo. Claims 4, 5, 18, 19, 25, 26, 32, 33, 40, 41, 52, 53, 64, and 65 stand rejected under 35 U.S.C. § 103(a) as being unpatentable based on combination of Matsuo and U.S. Patent No. 5,979,757 ("Tracy").

Applicants believe that all pending claims, as amended, are allowable for at least the following reasons. Withdrawal of the rejections is respectfully requested.

Independent claims 1, 23, 30, 37, 49, and 61 have been amended herein to further clarify one of the aspects of the invention. Claim 16 originally recites such aspect, and thus has not been amended herein. Specifically, all independent claims 1, 16, 23, 30, 37, 49, and 61 require "restrictive display of prohibited items" in electronic commerce transactions. For example, claim 1 requires that "said taking action comprises modifying a display of items ... , wherein the display modification includes restricting display of items which are prohibited from being purchased by the customer based upon the predetermined criteria." Other independent claims contain recitations similar to those of independent claim 1. Support for the amendments is found at, for example, page 21, line 27 - page 22, line 9 of the present specification referring to Fig. 3A. No new matter has been introduced by these amendments.

As described at, for example, page 21, line 27 - page 22, line 9 of the present specification, the invention defined in independent claims 1, 16, 23, 30, 37, 49, and 61 is directed to a method/system for electronic commerce transactions. For example, a specific exemplary embodiment of the invention involves a modified (or, restricted) display of items based on predetermined criteria. In a specific exemplary embodiment, the products which are not allowed to be sold or delivered to a specific customer may be hidden or otherwise prevented from being

displayed to that customer. None of the cited references teach or suggest this modified display of regulated items as claimed.

The features added to independent claims 1, 23, 30, 37, 49, and 61 were originally recited in independent claim 16. The Breen patent, and the Matsuo patent were cited separately in rejecting claim 16. Applicants will argue the patentability of independent claims for each of these two references below.

#### Rejection based on Breen

The Breen patent generally relates to conducting regulation-compliant commercial transactions. However, nothing in Breen suggests the claimed modified display in any way. In fact, the Office Action does not specify which portion of the Breen patent shows the claimed feature, i.e., “restricting display of items which are prohibited from being purchased by the customer based upon the predetermined criteria.” The Examiner’s blanket rejection of claims including claim 16 does not clarify the reasoning why the Breen patent can be said to anticipate the claimed modified display.

The Office Action specifically points out that the Breen patent shows a registration process (Fig. 10A-F) and a login screen (Fig. 11). It is respectfully submitted that the description of Breen referring to these figures have nothing to do with the claimed feature since the registration process and the login process in Breen merely avoid unauthorized access to the web site based on the status of a buyer/seller, not based on “items which are prohibited from being purchased by the customer” as claimed. See, for example, column 15, lines 1-11 of Breen. Therefore, Breen cannot be said to anticipate the modified display feature as recited in independent claims 1, 16, 23, 30, 37, 49, and 61.

#### Rejection based on Matsuo

The Matsuo patent generally relates to an electronic settling system/method. As the Examiner concedes in section 7 of the Office Action, the Matsuo patent does “not teach the steps of restricting display of an item, preventing the customer from adding the item to a cart, or removing the item from a cart.” The Office Action provides only a blanket statement that “it would have been obvious ... to implement any of these steps to facilitate checkout,” without citing a specific portion of Matsuo on which the Examiner relied in rejecting the claims.

Applicants are unable to find any suggestion, implicit or explicit, of the claimed modified display scheme in Matsuo. Thus, if the Examiner believes that modified display as claimed is somehow implicitly suggested in the art of record, Applicants respectfully encourage the Examiner to specifically identify a relevant portion of Matsuo, on which the Examiner relies in

rejecting the claims so that Applicants can make meaningful assessment on the patentability of the claims.

In view of the foregoing, independent claims 1, 16, 23, 30, 37, 49, and 61 are believed to be patentable over the cited art.

The Examiner's rejections of the dependent claims are respectfully traversed. However, to expedite prosecution, all of these claims will not be argued separately. Other claims each depend either directly or indirectly from independent claims 1, 16, 23, 30, 37, 49, and 61, and therefore, are respectfully submitted to be patentable over cited art for at least the reasons set forth above with respect to claims 1, 16, 23, 30, 37, 49, and 61.

## **II. CONCLUSION**

Applicants believe that all pending claims are in condition for allowance, and respectfully request a Notice of Allowance at an early date. If the Examiner has any continuing concerns about patentability of the claimed invention, he is encouraged to telephone the undersigned at 510-843-6200, ext 245.

Respectfully submitted,  
BEYER WEAVER & THOMAS, LLP



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Limited Recognition under 37 CFR § 10.9(b)

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RESUBMITTED



**BEFORE THE OFFICE OF ENROLLMENT AND DISCIPLINE  
UNITED STATES PATENT AND TRADEMARK OFFICE**

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**Expires: August 28, 2004**

A handwritten signature in black ink, appearing to read "Harry I. Moatz", written over a horizontal line.

Harry I. Moatz  
Director of Enrollment and Discipline

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**JUN 09 2004**

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